

REMARKS

Status of the Claims

Claims 1-31 are pending. Claim 1 has been amended. Claims 4, 5, and 21-31 were withdrawn from consideration. Claims 1-3 and 6-20 stand rejected.

In-Person Interview

The Examiner is thanked for the courtesies extended during the in-person interview held on October 6, 2004.

Amendment of Claim 1

Claim 1 was amended as suggested by the Examiner.

Amendment of the Specification

The amendment of the specification has been adopted to clarify the cross-reference to other applications. The Examiner asserted that the provisional application serial no. 60/114,540, upon which priority was claimed, was filed more than one year subsequent to filing of the instant application. Provisional application serial no. 60/114,540 was filed December 29, 1998, and the instant application was filed on December 29, 1999, therefore the claim of priority is proper, and within the required time limits. No new matter has been added in the specification.

Requirement to Correct Sequence Listing

Applicant submits herewith a corrected sequence listing in both paper and computer readable formats. Also submitted is a declaration that the sequence listing in both formats is the same.

Rejection of Claims 1-3 and 6-20 under 35 U.S.C. §112, First Paragraph

In the Office Action claims 1-3 and 6-20 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a

way as to enable one skilled in the art, to make and/or use the invention. Specifically, the Office Action states that “[t]he recitation of claim 1 of a method for preventing a retroviral infection is not enabled” (Office Action, page 3, paragraph 11) (emphasis added). Although Applicant disagrees with the position of the U.S.P.T.O., the “preventing” language has been removed from claim 1 in order to advance the prosecution of instant application without prejudice to prosecute a claim or claims containing this language in another application. Applicant respectfully requests that this rejection be withdrawn.

Rejection of Claim 16 under 35 U.S.C. §112, Second Paragraph

Claim 16 was rejected under 35 U.S.C. §112, second paragraph. The Examiner asserted that claim 16 did not further limit claim 1. Inasmuch as claim 1 recites “N-glycolylneuraminic acid or a derivative thereof,” and claim 16 recites “N-glycolylneuraminic acid” only, it is believed that claim 16 further limits claim 1.

Rejection of Claims 1-3 and 20 under 35 U.S.C. §102(f)

It is asserted in the Office Action that the invention of claims 1-3 and 20 was not invented by the Applicant. Please find attached a Declaration under 37 C.F.R. 1.132 (“Sharma Declaration”) that clarifies the sole inventorship of the claimed invention by the Applicant, Yash P. Sharma. As set forth in his declaration, Dr. Sharma declares that he disclosed his invention under a secrecy agreement to scientists at NIH after he filed for patent protection. Sharma Declaration, ¶6. After this meeting at NIH, various individuals performed tests related to Sharma’s invention. Sharma Declaration, ¶¶ 7-10. It is respectfully requested that the rejection under 35 U.S.C. § 102(f) be withdrawn.

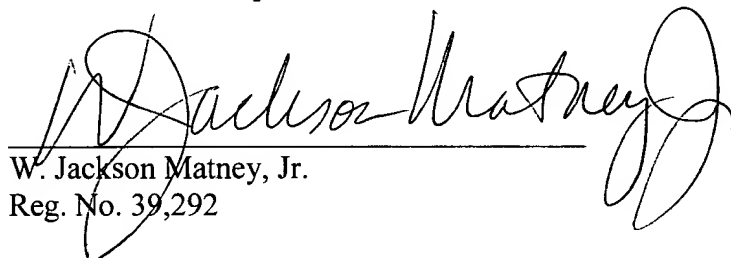
In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response; please charge any deficiency in fees or credit any overpayments to Deposit Account No. 10-0447 (66262-00002USPT).

Respectfully submitted,

JENKENS & GILCHRIST
A Professional Corporation



W. Jackson Matney, Jr.
Reg. No. 39,292

Date: December 3, 2004
Jenkins & Gilchrist, P.C.
901 15th Street, N.W., Suite 900
Washington, DC 20005
(202) 326-1500
(202) 326-1555 (fax)